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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/746,232	12/21/00	KRISHNAMURTHI R	QCPA483C

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EXAMINER	
SOBUTKA,P	
ART UNIT	**PAPER NUMBER**
2683	2

DATE MAILED: 07/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/746,232	Applicant(s) KRISHNAMURTHI ET AL.	
	Examiner Philip J. Sobutka	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☒ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1,2,5-7,10-13, are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (US 5,889,844).

Consider claims 1,6,10,11,13. Kim teaches a method for establishing a new call when an existing call is in progress comprising (Note that this constitutes a service negotiation) : delivering a first message from a mobile switching center to a base station for initiating service negotiation (Col 4, lines 23-35), negotiating a new service configuration by the base station and the subscriber (col 4, lines 36-65), and connecting the new call and existing call using the new service configuration (col 4, line 66- col 5, line 47).

As to claim 5, note that Kim's first message would function as a change service message.

As to claim 2, note that Kim's processing is performed by the MSC (fig 3, col 3, line 65- col 4, line 2).

As to claims 7,12, note that Kim teaches call conferencing i.e. both new and existing calls are accommodated.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3,4,8,9,14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim.

Consider claims 3,4. Kim lacks a teaching of the subscriber and base station including processors. Official Notice is taken that the use of microprocessors is well known in the art. It would have been obvious to one of ordinary skill in the art to modify Kim to use processors in order to perform the method using the smallest circuit

configuration. Note that Kim's base stations and mobiles would include transceivers and message generators.

As to claims 8,14, Kim lacks a teaching of using CDMA. Official Notice is taken that CDMA is well know in the art. It would have been obvious to one of ordinary skill in the art to modify Kim use CDMA in order to provide superior interference reduction and privacy.

As to claims 9, 12, note that when the subscriber required a. hand-off it would be in contact with a target base station.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-5,9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 2 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 2 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

8. Claim 6 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 7 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 7 of 6,198,929 to work with different target base

station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

9. Claim 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 7 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 8 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

10. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 3 of 6,198,929 requires specific structure for the target base station it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 3 of 6,198,929 to work with different target base station arrangements in order to increase the versatility of the arrangement by eliminating the need to alter all base station elements.

11. Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 12 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 12 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

12. Claim 11 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 17 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 17 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 17 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

13. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 18 of 6,198,929 requires the existing call to be an SMS

call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 18 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

14. Claim 13 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 19 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill in the art to modify claim 19 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

15. Claim 14 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,198,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because while claim 14 of 6,198,929 requires the existing call to be an SMS call, it would be apparent to one of ordinary skill in the art that the difference would depend more on engineering design considerations and would not affect the overall operation of the invention. Therefore it would have been obvious to one of ordinary skill

in the art to modify claim 14 of 6,198,929 to work with all types of existing calls in order to increase the versatility of the arrangement by allowing it to be used with voice calls.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Sobutka whose telephone number is 703-305-4825. The examiner can normally be reached on Monday-Friday 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Philip Sobutka

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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pjs
June 30, 2001